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Paper No. 10
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Delray Technologies, Inc.

Serial No. 75/622,513

Brian M. Mattson of Patents+TMS, P.C. for Delray Technologies, Inc.

Wm. Patrick Shanahan, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Acting Managing Attorney).

Before Quinn, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Delray Technologies, Inc. seeks registration of the mark
DIRECTWAVERADIO.NET for the following services:

"providing multiple-user, wireless access to a
global computer information network," in
International Class 38; and

"global computer network development services,
namely, designing and implementing web sites for
others," in International Class 42.¹

The Trademark Examining Attorney has refused registration
on the ground that applicant's mark is merely descriptive of

¹ Application Serial No. 75/622,513, filed on January 19, 1999, based upon applicant's claim of a *bona fide* intention to use the mark in commerce.

its services, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed. The case has been briefed but applicant did not request an oral hearing. We affirm the refusal of registration as to both classes of services.

The Trademark Examining Attorney begins by taking the second level domain name, DIRECTWAVERADIO, and breaking it down into the three-word phrase "direct wave radio." Using technical articles, he shows the relevance of this terminology to the services herein, and shows that wireless Internet access is possible using just such radio waves.

By contrast, applicant charges that the Trademark Examining Attorney has improperly dissected this mark, which is at worst, suggestive of the access services in International Class 38 and which is arbitrary as applied to its Web development services in International Class 42.

It is well settled that a term is considered to be merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately conveys information about an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services with which it is being used. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed.

Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. On the other hand, the immediate description must be conveyed with some "degree of particularity." In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. Feb. 13, 1991); and In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1987).

Furthermore, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought. Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). We must look to the context in which the term is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. In re Bright-Crest Ltd., 204 USPQ 591, 593 (TTAB 1979).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See In re Abcor Development Corp., *supra* at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984).

The evidence placed into the record by the Trademark Examining Attorney shows that radio signals are made up of electromagnetic oscillations, or waves. The ways in which radio signals travel from a transmitter to a receiver are known as propagation modes (e.g., direct waves, surface waves and reflected waves). The "direct wave" is a radio signal that travels directly from the transmitting antenna to the receiving antenna via line of sight. Whether marine use, microwave transmissions, cellular telephones, broadcasting or paging, the NEXIS articles made of record show that one of the consistent goals of telecommunication specialists has been achieving good direct wave conditions between a transmitting antenna and the receiving antenna.

However, applicant argues that this combination of terms, combined by applicant in a novel manner, creates a distinctive term:

... [E]ven if certain individual components of the proposed mark are descriptive, the combination is not merely descriptive per se. Applicant's mark, "DIRECTWAVERADIO.NET," provides a combination of terms that creates a distinct commercial impression which is not descriptive. (Applicant's appeal brief, p. 3).

Moreover, applicant argues that the Trademark Examining Attorney has improperly dissected the mark:

The Examining Attorney, by providing articles discussing the term "direct wave" and "radio" has, in essence, deemed the mark descriptive by means of dissecting the mark into its individual terms. However, the courts have established that dissection of a mark into individual components is an incorrect approach. (Applicant's appeal brief, p. 3).

Finally, in arguing that this term is at worst suggestive of the Internet access services in International Class 38, applicant argues as follows:

Appellant contends that the nature of the services for International Class 38, namely, access to a global computer information network, could not be ascertained simply from the mark itself. *Direct wave radio frequencies* may be able to transmit numerous types of signals. Consequently, one may not discern from the mark that *direct radio wave frequencies* are provided for internet access without some thought or imagination... (Applicant's appeal brief, p. 4-5) [Underlining in original, *Italics* supplied].

As noted by the Trademark Examining Attorney, in the course of making this latter argument, applicant seems to have contradicted its earlier argument of dissection, at least of

the term "DIRECTWAVERADIO," by repeatedly using the term "Direct wave radio frequencies" in the context of wireless Internet access. Furthermore, as noted earlier, whether a term is merely descriptive is determined not in the abstract but in relation to the services for which registration is sought. Accordingly, inasmuch as direct wave radio may well be the mode of radio signal propagation involved in applicant's wireless Internet access, we find this portion of the mark descriptive of a feature of the listed services in International Class 38. Furthermore, placing this matter into the format of an Internet domain name does not confer trademark significance on any otherwise descriptive term:

The proposed mark, DIRECTWAVERADIO.NET, is in the form of an Internet domain name. Although not argued by the applicant, the Top Level Domain indicator, .NET, adds no trademark significance to the proposed mark [citations omitted]
(Trademark Examining Attorney's appeal brief, p. 5).

Accordingly, we have no doubt that this proposed mark is merely descriptive of the wireless Internet access services recited in International Class 38.

We acknowledge that it is a closer case, based upon the instant record, whether the term "Direct Wave Radio" conveys with particularity a significant feature of applicant's Web development services in International Class 42. However, one

of the implications of the growth of wireless access to the Internet is that businesses having Web sites undoubtedly are increasingly considering wireless users and their needs rather than just traditional wired PC users. As Internet sites reshift their priorities and retool their technologies for the shift to wireless, there will be a growing need for the Web development services of vendors like applicant in retraining staff and helping Webmasters to rethink their entire product lines as to both style and content. Hence, to the extent that "Direct Wave Radio" is inextricably linked to wireless Internet access, it does not require imagination, thought or perception to find that this phrase immediately conveys information to prospective purchasers about the unique Web development services provided by applicant in this rapidly changing environment.

Decision: The refusal to register is affirmed as to both classes.